



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,353	02/14/2001	Franklin Sadler Love III	41012/208363	1080

826 7590 12/19/2002

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER

HONG, JOHN C

ART UNIT PAPER NUMBER

3726

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,353

Applicant(s)

LOVE ET AL.

Examiner

John C. Hong

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) 1-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 63-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group III, claims 63-91 in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 74 and 75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 74, line 2, "spraying a fan shaped jet of the media" is not clear.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 63 and 73-79, 90 and 91 are rejected under 35 U.S.C. 102(b) as being anticipated by Novak et al. (U.S. Patent 4,877,638).

Novak et al. disclose a continuous method of descaling a layer of scale

Art Unit: 3726

on an advancing metal surface **12** without the use of caustic materials, the method comprising: advancing a metal surface along a predetermined path of travel; cracking the layer of scale by spraying a fan shaped jet of media **6** under fluid pressure at the surface of advancing metal; and abrading with brush **18** the cracked layer of scale to remove the scale thereby forming a descaled metal surface (Fig. ; col. 2, lines 4-11).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 64-67 and 85-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novak et al. (U.S. Patent 4,877,638) .

Novak et al. fail to teach : the roughness of the metal surface (2.5/1.5 micron Ra), the metal surface speed (100fpm/400fpm); SEM/EDS percent residual surface oxygen measurement of less than 4%; and residual particle contents of from 0.1% to 1%; surface PH of 7 or above.

But specifically claimed roughness, SEM/EDS percent residual surface oxygen measurement and residual particle contents are considered to have been obvious matters of choice, since it has been held that discovering an optimum value of result effective variable involves only routine skill in the art. *in re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

8. Claims 68-72 and 80-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novak et al. in view of Safien et al. (U.S. Patent 4,250,726).

Novak et al. fail to teach the steps of : spraying smooth edged media (claim 68) ; spraying ceramic beads having mean particle diameter within range of .025 mm to 1 mm/.07 mm to .14 mm. (claims 69 - 71); spraying glass beads at the metal surface ; cracking step comprises: additionally up-firing the media at a bottom surface of the metal; up-firing the media at a bottom surface of the metal; spraying top and bottom of the metal ; and abrading step comprises abrading top surface and bottom surface of the metal (claims 80-84).

Safien et al. teach the steps of : spraying smooth edged media; spraying ceramic beads having mean particle diameter within range of .025 mm to 1 mm/.07 mm to .14 mm ; spraying glass beads at the metal surface (col. 3, lines 14-16; col.6, lines 5-7; 39-42); cracking step comprises: additionally up-firing the media at a bottom surface of the metal; up-firing the media at a bottom surface of the metal; spraying top and bottom of the metal ; and abrading step comprises abrading top surface and bottom surface of the metal (col. 4, lines 60-62; col. 5, lines 14 and 15; 66 and 67)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to employ the step of spraying smooth edged media ; spraying ceramic beads having mean particle diameter within range of .025 mm to 1 mm/.07 mm to .14 mm; spraying glass beads at the metal surface ; cracking step comprises: additionally up-firing the media at a bottom surface of the metal; up-firing the media at a bottom surface of the metal; spraying top and bottom of the metal ; and abrading step comprises abrading top surface and bottom surface of the metal, as taught by Safien et al. on the method of Novak et al. so as to produce a mirror or dull finish on the rolled article of stainless steel or aluminum alloys economically (col. 2, lines 36-42).

Art Unit: 3726


Regarding specifically claimed particle diameter of the beads are considered to have been obvious matters of choice, since it has been held that discovering an optimum value of result effective variable involves only routine skill in the art. *in re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John C. Hong whose telephone number is 703-305-0779. The examiner can normally be reached on M-F(07:00-16:30)First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

jh
December 16, 2002


JOHN C. HONG
PATENT EXAMINER